

1. REMARKS / DISCUSSION OF ISSUES

Claims 1-5, 7-15 and 17-20 are pending in the application. Claims 1-5, 7-14, 19 and 20 are allowed. Claim 18 is indicated as having allowable subject matter.

Because no amendments to the claims are made in the present Response, a listing of the pending claims is not included per 37 CFR 1.121.

Request for Personal Interview

Applicants respectfully request a personal interview with the Primary Examiner Wujiciak at a convenient time before further action on this application. Applicants believe that a personal interview will clarify certain aspects of the rejected claims and advance all claims to issue. The undersigned attorney will contact the Examiner after filing this Response in an effort to set a convenient date and time for such an interview.

Rejections Under 35 U.S.C. § 103

Claims 15 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chuang* (U.S. Patent 5,800,311) in view of *Mishler* (U.S. Patent 5,353,655).

Analysis of obviousness under 35 U.S.C. § 103 requires determination of the scope and content of the prior art, the differences between the prior art, and the claims at issue, and the level of ordinary skill in the pertinent art. *W.L. Gore & Associates v. Garlock* 220 USPQ 303, 311 (1983) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (CAFC 1966)). There must be content present in the prior art teachings to suggest to one skilled in the art that the claimed invention would have been obvious. *W.L. Gore & Associates* at 311

(citing *In re Bergel* 130 USPQ 206, 208 (CCPA 1961); and *In re Spinnoble* 160 USPQ 237, 244 (CCPA 1969)).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is a reason, suggestion or motivation to do so. The reason, suggestion or motivation may come from references themselves; from knowledge of those skilled in art that certain references or disclosures in references are known to be of interest in the particular field; or from nature of the problem to be solved to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.* 37 USPQ2d 1626 (CAFC 1996). Prior knowledge in the field must be supported by tangible teachings in reference materials. *Cardiac Pacemakers Inc. v. St. Jude Medical Inc.* 72 USPQ 2d 1333, 1336 (CAFC 2004).

Hindsight is not an appropriate motivation for combining references and the requisite knowledge available to one of ordinary skill in the art. Relying upon hindsight knowledge of applicants' disclosure when the prior art does not teach nor suggest such knowledge results in the impermissible use of the invention as a template for its own reconstruction. *Sensonics Inc. v Aerosonics Corp.*, 38 USPQ 2d 1551-1554 (CAFC 1996), citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 220 USPQ 303.

a. The applied art does not disclose nor suggest the plurality of magnets as featured in claim 15

Claim 15 is drawn to an optomechanical system including:

“...a plurality of magnets attached to the housing and magnetically attracted to the sphere, the magnets so constructed and arranged in the housing such that the sphere has freedom for prescribed movement when required by overcoming

the magnetic attraction between the sphere and the magnets, but is otherwise held stationary by the magnetic attraction.”

Applicant respectfully submits that *Chuang* lacks at least the disclosure of at least the noted feature of claim 15. *Chuang* does disclose a magnet ring 34 that cooperates with coils 53 to provide current to lighting elements 43 to indicate rotation of the sphere. As the Office Action notes, the reference does not disclose a plurality of magnets. Moreover, there is no teaching or suggestion in *Chuang* to incorporate a plurality of magnets and especially the disclosure of a plurality of magnets constructed and arranged in a housing to maintain the sphere stationary excepting the rotation as specifically set forth in claim 15.

The Office Action turns to *Mishler* in an attempt to cure the lacking of a disclosure of a plurality of magnets. *Mishler* does disclose the inclusion of one or magnets 41 for use in a gyroscope. The magnet(s) 41 disclosed in *Mishler* generates electricity for various audio and/or visual devices. However, there is no description whatsoever of *the magnets so constructed and arranged in the housing such that the sphere has freedom for prescribed movement when required by overcoming the magnetic attraction between the sphere and the magnets, but is otherwise held stationary by the magnetic attraction*. Rather, the magnets in *Mishler* are supererogatory to the function of the gyroscope, and only provide electrical power for audio and/or visual devices 46 shown in Fig. 8.

Applicants emphasize that the single magnetic ring disclosed in *Chuang* and the one or more magnets disclosed in *Mischler* are used to provide a magnetically induced current/electrical power to lighting elements, and to audio and/or visual devices, respectively. The references taken alone or (assuming arguendo properly combined) together do not teach or suggest the use of a plurality of magnets for any other purpose, **and especially do not teach the maintaining of the sphere as featured in claim 15.**

For at least the reasons set forth above, Applicant submits that the rejection based on *Chuang* and *Mischler* is improper and should be withdrawn.

b. Chuang and Mischler are both non-analogous art

In addition to the foregoing, Applicant submits that the references to *Chuang* and *Mischler* are not pertinent art and thus cannot serve to establish a rejection under 35 U.S.C. § 103(a).

The determination that a reference is from a non-analogous art is two-fold. First, the reference must be within the field of the inventor's endeavor. If it is not, the reference must be reasonably pertinent to the particular problem with which the inventor was involved. *In re Dillon* 16 USPQ 2d 1897 (CAFC 1990).

Chuang relates to a wrist exerciser, which is outside the realm of the optomechanical system of claims 15 and 17. These technical fields are disparate and thus one skilled in the art of optomechanical systems would not look to and consider wrist exercises within his or her field of endeavor when addressing a problem to be solved.

Furthermore, claim 15 addresses the securing of the sphere 105 with a plurality of magnets. Contrastingly, *Chuang* incorporates a magnetic ring 34 in cooperation with coils 53 to provide current to lighting elements indicating the movement of a rotator during exercise. As noted above, *Chuang* lacks the disclosure of securing a sphere with a plurality of magnets as recited in claim 15. Therefore, *Chuang* is not reasonably pertinent to the specific problem that the invention of claim 15 addresses. (See column 4, lines 16-54 of the reference to *Chuang*.)

Mischler is drawn to a gyroscope. The gyroscope does not include optical elements, and does not even mention the term 'optical' therein. The only aspect of the description that relates in any way to light is the visual device 46 of Fig. 8.

This is an LED, which is used to provide light for a counter or a flashlight. Respectfully, the optomechanical system of claims 15 and 17 and the gyroscope of *Mischler* are within technical fields that are disparate. Thus one skilled in the art of optomechanical systems would not look to and consider gyroscopes with no optomechanical function within his or her field of endeavor when addressing a problem to be solved.

Furthermore, claim 15 addresses the securing of the sphere 105 with a plurality of magnets. Contrastingly, *Mischler* like *Chuang* incorporates a magnet in cooperation with a coil 42 to **provide current to a device**. As noted above, *Mischler* **lacks the disclosure of securing a sphere with a plurality of magnets** as recited in claim 15. Therefore, *Mischler* is not reasonably pertinent to the specific problem that the invention of claim 15 addresses. (See column 4 of the reference to *Mischler*.)

For at least the reasons set forth above, it is respectfully submitted that the rejection of claim 15 based on *Chuang*, or *Mischler*, or both, is improper. Additionally, the rejection of claim 17, which depends from claim 15, is similarly improper. It is respectfully requested that the rejection of claims 15 and 17 be withdrawn and that claims 15 and 17 be allowed.


Conclusion

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:

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